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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/021,650 | 12/11/2001 | Ross E. Waltz | 01-1207 | 9228 |
| 7590 | 03/12/2004 | | EXAMINER | |
| Herbert C. Schulze 2790 Wrondel Way, # PMB36 Reno, NV 89502 | | | POE, MICHAEL I | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1732 | |

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/021,650 | WALTZ, ROSS E. | |
| | Examiner | Art Unit | |
| | Michael I Poe | 1732 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, drawn to a business model algorithm for preparation of a shaped block from an aggregate material, classified in class 264, subclass 333.
 - II. Claims 4 and 5, drawn to an apparatus for forming landscape edging blocks, classified in class 425, subclass 398.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced, at least in part, by hand by placed the preform into the die set means by hand without the use of means.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with applicant's attorney Herbert Schulze on February 24, 2004, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-3. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4 and 5 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

5. It is noted that this application appears to claim subject matter disclosed in prior Application No. 09/448,274, filed January 24, 1999. A reference to the prior application must be inserted as the first sentence of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant

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intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. Also, the current status of all nonprovisional parent applications referenced should be included.

Although the applicant has provided a reference to the prior application including its relationship to the instant application, the applicant has not provided the current status of the prior application (e.g., now abandoned) in this reference. The applicant should amend the specification to include the current status of the prior application in response to this Office action.

Specification

6. The disclosure is objected to because of the following informalities: (1) "patent number 5,119,587" should be "U.S. Patent No. 5,119,587" on page 5, 2nd paragraph, lines 3-4; (2) the descriptions of the drawings on pages 9 and 10 should have the descriptions listed according to the numerical order of the figure numbers (e.g., the description of Figure 2a should be before the description of Figure 3, etc.); and (3) ".." should be "." on page 17, 2nd paragraph, line 10 and on page 21, 1st paragraph, line 8.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the business method steps defining the business algorithm. Specifically, although the preamble of claim 1 recites a business model algorithm, the body of claim 1 only recites utility steps (e.g., steps for molding a shaped block from an aggregate material) and does not recite any business steps necessary for defining the business model. In order for the claim to be classified as a business method or algorithm, there must be at least some business steps recited. Typical business steps in block making

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business model would include, for example, steps of taking order from customers, obtaining the desired design specification from the customers, molding blocks according to the design specification, delivering the molded blocks to the customers, etc. Since the applicant has not recited any business steps in the claims, the current claims are being treated as utility claims for the purpose of this Office action.

9. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 includes the recitations "at least one shaped block finish die set and preform container are prepared" and "a preform is prepared using a preform container or an extruder". These recitations are confusing to one reading the claims when taken in view of each other. Specifically, as outlined in the applicant's original disclosure, the preform container is not needed when extrusion is used to form the preform. As such, if an extruder is used to form the preform in step III, there would be no need to prepare a preform container in step I. For the purpose of this Office action, the examiner has assumed that step I comprises preparing at least one shaped block finish die set and does not comprise preparing a preform container.

Claim 3 includes the recitation "the dry mix aggregate material preform is in into a pyramid-like shape". This recitation is confusing because it would be unclear to one of ordinary skill in the art what shapes the applicant would consider to be pyramid-like. Specifically, it is not clear to one reading the claims whether the applicant would consider another shape, such as a conical shape, to be pyramid-like. For the purpose of this Office action, the examiner has assumed that the preform is pyramid shaped.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,080,130 (Seifert).

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Claim 1

Seifert teaches a method of extruding, lining and pressing clay blanks (preparation of a shaped block from an aggregate material) including extruding a clay strand from a clay extruder (a preform is prepared using a preform container or an extruder); cutting the strand into a plurality of clay blanks (a preform is prepared using a preform container or an extruder); feeding the extruded clay blanks to a molding press (at least one shaped block finish die set is prepared; the preform is placed into the finished die set) comprising a mould cavity defined by at least two relatively movable mould sections; molding the clay blanks into articles using the molding press (pressure is applied to the finish die set to force the preform into the final shape of the shaped block); and removing the molded articles from the molding press (the shaped block is removed from the finish die set) (column 1, line 60 - column 2, line 2; column 2, line 64 - column 3, line 7; column 3, lines 34-42 and 54-60; column 4, line 48 - column 5, line 30).

Seifert further teach that clay in the sense of his invention is intended to include any clay-like pressure-moldable wet material used in the manufacture of ceramics, including ordinary pottery clay, porcelain clay and stoneware clay (a quantity of dry mix aggregate material is prepared) (column 2, lines 53-57). Note that, as defined in the second paragraph on page 14 of the applicant's original disclosure, "dry" may be inclusive of a very minimal amount of water. Therefore, although Seifert appears to teach away from a dry material by defining the clay as a wet material, the wet material of Seifert would actually be readable on the "dry mix aggregate material" as defined by the applicant's original disclosure.

Note that the claims do not convey any structure to the term "shaped block". Therefore, based upon the broadest reasonable interpretation of the term "shaped block", any molded article would be readable on a "shaped block" as currently claimed.

Seifert does not specifically teach that the clay article is cured or hardened after molding. However, the examiner takes official notice that it is notoriously well known in the art at the time the invention was made to cure or harden clay articles after molding and removing said articles from the mold. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made and one of ordinary skill would have been motivated to cure the clay articles after molding in the process of Seifert as was well known in the art to provide a shape stable article that could be more easily handled and transported without distorting its molded shape.

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Claims 2 and 3

The discussion of Seifert as applied to claim 1 above applies herein.

Seifert does not specifically teach the claimed shapes (e.g., semi-cylindrical or pyramid-like) of the preform. However, in this regard, the court has held that changes in shape are a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular shape was significant [see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) and MPEP Section 2144.04]. In the instant case, the applicant has not provided any persuasive evidence that the shape of the preform is significant and would materially affect the claimed process. Therefore, the examiner stipulates that the claimed shapes of the preform are an obvious matter of choice, and therefore the shape of the preform in the instant claims does not carry any patentable weight.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. RE 24,527 (Ripley), U.S. Patent No. 3,450,808 (Roberts), U.S. Patent No. 4,225,545 (Munk et al.), U.S. Patent No. 4,596,686 (Persson), U.S. Patent No. 2,219,606 (Van Schoick), U.S. Patent No. 3,639,555 (Steffan), U.S. Patent No. 5,779,957 (Champomier et al.), U.S. Patent No. 3,060,542 (Martin), U.S. Patent No. 5,766,538 (Kossman), and German Patent Publication No. DT 2507046 A1 (Winter) have been cited of interest to show the state of the art at the time the invention was made.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael I Poe whose telephone number is (571) 272-1207. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Poe/mip

MICHAEL COLANINI
PRIMARY EXAMINER

